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| 53796 7590 09/29/2010 PILLSBURY WINTHROP SHAW PITTMAN, LLP c/o SUSAN TRADER 1650 TYSONS BOULEVARD P.O. BOX 10500 MCLEAN, VA 22102 | | | | |
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW ROUSE, QUINTON ZONDERVAN, THOMAS
BENTLEY, TIMOTHY LAWSON, and CHRISTOPHER HEROT

Appeal 2009-003644
Application 09/750,302
Technology Center 2400

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and THU A.
DANG, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 21-40, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b). Appellants requested but later waived an oral hearing.

We affirm.

Invention

Appellants' invention relates to enabling users to send and receive messages and other information from mobile device, and allow customization of various aspects of views and applications. *See* Abstract.

Representative Claim

21. A method of formatting content for display on a mobile wireless client device that is based on a form that is used to display content on a desktop computer, the form being associated with an action that is executable by an application, wherein the form is stored remotely from the mobile wireless client device, the method comprising:

- displaying an action menu on the wireless client device, the action menu including a plurality of action options;
- enabling selection of the action from the action menu displayed on the mobile wireless client device;
- receiving, via a wireless medium, the selection of the action from the mobile wireless client device;
- executing the action remotely from the mobile wireless client device, wherein executing the action generates content;
- providing a mobile design element that corresponds to the form and is associated with the mobile wireless client device;
- formatting the content according to the mobile design element,
- transmitting the content that is formatted according to the mobile design element to the mobile wireless client device, and
- storing the mobile design element remotely from the mobile wireless client device in a application digest.

Examiner's Rejections

Claims 21-40 stand rejected under on the ground of nonstatutory obviousness-type double patenting over claims 1-28 of US 7,142,883 (Rouse et al.).

Claims 21-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kahan (US 2002/0024536 A1).

Claims 21-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kikinis (US 6,076,109).

FINDINGS OF FACT

We refer to, and rely on, the Examiner's findings set forth in the Final Rejection and the Answer.

PRINCIPLES OF LAW

The *claims* measure the invention. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

"Giving claims their broadest reasonable construction 'serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.'" *In re Amer. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). "Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage." 367 F.3d at 1364.

ANALYSIS

Obviousness-type Double Patenting

Appellants indicate that the rejection for obviousness-type double patenting is not being appealed. Appellants submit that they will “consider filing a Terminal Disclaimer to overcome this rejection after the claims have been determined to otherwise be in condition for allowance.” App. Br. 2 n.

1.

However, the claims and the double patenting rejection are before us. The Examiner has not withdrawn the rejection, but repeats it in the Answer. In view of the lack of substantive response from Appellants, we summarily sustain the nonstatutory obviousness-type double patenting rejection of claims 21 through 40.

Prior Art

Independent claim 21 recites in the preamble a method of formatting “content” for display on a mobile wireless client device that is “based on a form that is used to display content on a desktop computer.” The method includes the steps of providing a mobile design element “that corresponds to the form” and which is associated with the mobile wireless client device, and formatting the content according to the mobile design element.

According to Appellants, these claim 21 features enable the user to receive information on the mobile wireless client device “in a format similar to the format in which the information would be presented to the user on a desktop computer.” App. Br. 8; Reply Br. 4. Kikinis is alleged not to format information “in a manner that mimics a customizable form used to present information to a user on a desktop computer.” App. Br. 9. Although

Appellants acknowledge that Kahan describes formatting content on a mobile terminal according to predetermined settings. Appellants allege that Kahan's subscriber provisioning profile (mobile design element) is not something that "corresponds to a form that is used to display content on a desktop computer." *Id.* at 15 (emphasis deleted).

According to Appellants, the claim 21 preamble feature of formatting content for display on a mobile wireless client device that is "based on a form that is used to display content on a desktop computer" is described in the Specification at page 12, lines 6 through 12. App. Br. 3, "Summary of Claimed Subject Matter." The steps of providing a mobile design element that "corresponds to the form" and formatting the content according to the mobile design element finds support at page 30, lines 5 through 21 of the Specification. *See id.* at 4.

The Specification thus provides the following text as support for the phrase "based on a form that is used to display content on a desktop computer."

Request handlers 214 may include requests related to basic operations (e.g., open application, read, view, open document, read item, edit document, save document, delete document, create document, etc.), electronic mail (e.g., compose mail, send mail, save draft, etc.), calendar (e.g., process invite, read calendar, add calendar, schedule meeting, fax calendar, etc.), search functions (e.g., address search, find address, application search, etc.), and miscellaneous (e.g., edit user profile, save user profile, login, go to home deck, load script, move to folder, session term, etc.).

Spec. 12:5-11.

The Specification later speaks more about "forms."

Multiple types of forms may be used by the present invention for various applications. Different types of forms may include facsimile, memorandum, invitation, user profile and other applications. Forms for each application may include predetermined form fields that are specific to each application. Forms may be created, modified and forwarded (or sent) to one or more selected recipients. Other operations may also be performed.

For example, forms may be displayed as brief forms and full forms. Other options are also available. For example a full form may display all the fields available while a brief form may display the fields selected (or customized) by the user.

Spec. 24:15 - 25:3.

In light of the Specification, providing a mobile design element that “corresponds” to a “form that is used to display content on a desktop computer” as claimed does not require that the content displayed at the wireless client device be “in a format similar to the format in which the information would be presented to the user on a desktop computer” as alleged by Appellants. Moreover, even if the claim were so limited, there would be no guidance for determining when a “similar” format is sufficiently “similar” to be within the scope of the claim.

Because Appellants’ arguments are not commensurate with the scope of claim 21, we are not persuaded of error in the Examiner’s finding that the claim is anticipated by each of Kahan and Kikinis.

Although the Appeal Brief places additional claims in separate headings, the arguments under some of the headings rely solely on the improper interpretation of what claim 21 requires with respect to formatting content for a wireless client device. Claims 22, 24-27, 29-32, 34-37, 39, and 40 thus fall with claim 21. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 23 recites that the method of claim 21 further comprises customizing the form according to settings selected on the wireless client device. Although the Appeal Brief alleges that the portions of Kikinis and Kahan identified in the Final Rejection do not disclose the subject matter of claim 23, Appellants filed a reply brief but did not respond to the Examiner's additional findings in the Answer that are directed to claim 23. Appellants have thus not demonstrated error in the finding that Kahan describes customizing the form according to settings selected on the wireless client device by its disclosure of the change profile selection 62 (Fig. 6; ¶ [0092]). Nor have Appellants demonstrated error in the finding that Kikinis' description of scaling a bitmap according to the user ID received from the device (col. 10, ll. 30- 35) meets the requirements of claim 23.

We are therefore not persuaded of error in either § 102 rejection of claim 23. Claims 28, 33, and 38, not separately argued, fall with claim 23. *See* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

The rejection of claims 21-40 on the ground of nonstatutory obviousness-type double patenting over claims 1-28 of US 7,142,883 is affirmed.

The rejection of claims 21-40 under 35 U.S.C. § 102(e) as being anticipated by Kahan is affirmed.

The rejection of claims 21-40 under 35 U.S.C. § 102(e) as being anticipated by Kikinis is affirmed.

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Application 09/750,302

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

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